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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ranjit N. Notani

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i2 TECHNOLOGIES US, INC.
ONE i2 PLACE, 11701 LUNA ROAD
DALLAS, TX 75234

EXAMINER

SWARTZ, JAMIE H

ART UNIT

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3694

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/971,718	Applicant(s) NOTANI ET AL.	
	Examiner JAMIE H. SWARTZ	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. This action is in response to the amendment filed on March 12, 2009. Claims 1-31 are pending. Claims 1-2, 4-6, 8, 11-12, 14, 15-16, 18, 21-24, 25-31 are amended. No claims have been added. Claims 32-50 have been cancelled.

Response to Arguments

2. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

3. The applicant has continued to use the term meta-model. The examiner based on a broad reasonable interpretation is interpreting a meta-model to mean a description of the structure of what data fields are included in the agreement. Such as the uses in EDI and DTD.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-31 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Regarding claims 1-31, the phrase "meta-model" renders the claim indefinite because it is unclear what the applicant means to be a meta-model. The applicant states in the specification that a "meta-model" describes a trade partner agreement. The examiner is reading meta-model to mean a description of the structure of what data fields are included in the agreement. Such as the uses in EDI and DTD.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to

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transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article.” (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, “Process claim that recites fundamental principle, and that otherwise fails ‘machine-or-transformation’ test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere ‘insignificant post-solution activity.’” (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)). The claims have to be tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing. Claims 11, 14-16, 19-20, are non-statutory under § 101 because the mere recitation of a machine in the preamble with an absence of a machine in the body of a claim fails to make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495). Though the applicant states the use of a computer in the preamble the use of the computer is not throughout the body of the claim and thus the claim is not statutory.

Claim Rejections - 35 USC § 102

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9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Brodsky et al. (US 20020046294 A1).

11. Referring to Claim 1, Brodsky teaches a storage medium stored therein a set of one or more meta-model elements, each of the one or more meta-model elements is incorporated into a negotiated meta-model that describes an agreement between two or more enterprises as to collaborations between the two or more enterprises, each of the one or more meta-model element comprising data describing a standard for collaboration between the two or more enterprises (§§ 111-131, 141, 146, 168, 90).

Brodsky teaches receive an indication that two or more enterprises wish to negotiate a standard for collaborations between the two or more enterprises (§§ 2490). Brodsky teaches provide the two or more enterprises access to the set of one or more meta-model elements (§§ 2503). Brodsky teaches receive selections of one or more of the meta-model elements for negotiation and incorporation into a negotiated meta-model, the negotiated meta-model describing an agreement between the enterprises as to collaborations between the two or more enterprises (§§ 78, 36, 2493, 2488, 55, 25, 23,

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107). Brodsky teaches facilitate negotiation of the selected meta-model elements between the two or more enterprises (§ 2490, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches incorporate negotiated meta-model elements into the negotiated meta-model for collaborations between the two or more enterprises (§ 2503, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches communicate the negotiated meta-model to the two or more enterprises for collaborations between the two or more enterprises according to the standard for collaborations in the negotiated meta-model (§ 2503).

12. Referring to Claim 2, Brodsky teaches wherein the meta-model negotiation service is configured to communicate the negotiated meta-model to collaboration software of the enterprises, the collaboration software configured to understand and collaborate according to the negotiated meta-model substantially automatically and substantially independent of modification to the collaboration software subsequent to negotiation of the meta-model (§ 16, 2496, 17, 90, 146, 84).

13. Referring to Claim 3, Brodsky teaches wherein the agreement associated with the negotiated meta-model is machine-actionable at the collaboration software of the enterprises and reflects a private, differentiated standard for collaboration customized for particular needs of the enterprises (§ 59, 1115, 1290).

14. Referring to Claim 4, Brodsky teaches wherein each of the one or more meta-model elements within the set comprise one or more of the following: role types;

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dimensions each comprising a supply chain element; dimensionalities each comprising a combination of supply chain elements; access of particular role types to particular dimensionalities; collaborative transaction types relative to particular dimensionalities; shared operations visible to the at least two enterprises; temporal structures of collaborative transactions (§ 36, 2493, 2488, 55, 25, 36, 2493, 23, 107).

15. Referring to Claim 5, Brodsky teaches wherein each of the one or more meta-model elements specifying a collaborative transaction type relative to a particular dimensionality comprises one or more of the following: structure of the transaction; data elements associated with the transaction; a state model describing a life cycle of the transaction; access that a role type has to data elements of the transaction relative to a state of the transaction; actions that a role type can execute on the transaction relative to a state of the transaction; whether the transaction is a system of record or whether synchronization must occur with another system of record (§ 248, 2493, 125, 123, 183, 193).

16. Referring to Claim 6, Brodsky teaches wherein the set of the one or more meta-model elements is specified in a template (§ 1344-1363).

17. Referring to claim 7, Brodsky teaches wherein the meta-model negotiation service comprises a joint business planning network service (JBPNS) (§ 2490, 2503)

18. Referring to Claim 8, Brodsky teaches wherein the meta-model negotiation service is associated with a network service provider through which the enterprises can negotiate the set of one or more meta-model elements (§ 2487).

19. Referring to Claim 9, Brodsky teaches wherein the negotiated meta-model is represented using extensible markup language (XML) (§ 18-21, 79).

20. Referring to Claim 10, Brodsky teaches wherein a collaboration comprises execution of a business process or transaction according to the negotiated meta-model (§ 42, 2503, 792).

21. Referring to Claim 11, Brodsky teaches receive an indication that two or more enterprises wish to negotiate a standard for collaborations between the two or more enterprises (§ 2490, abstract). Brodsky teaches providing the two or more enterprises access to a set of one or more meta-model elements, each of the one or more meta-model elements is incorporated into a negotiated meta-model that describes an agreement between the two or more enterprises as to collaborations between the two or more enterprises, each meta-model element in the set comprising data describing a standard for collaboration between the two or more enterprises (§ 111-131, 146, 168, 141, 90). Brodsky teaches receive selections of one or more of the meta-model elements for negotiation and incorporation into a negotiated meta-model, the negotiated

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meta-model describing an agreement between the enterprises as to collaborations between the two or more enterprises (§ 78, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches facilitate negotiation of the selected meta-model elements between the two or more enterprises (§ 2490, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches incorporate negotiated meta-model elements into the negotiated meta-model for collaborations between the two or more enterprises (§ 2503, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches communicate the negotiated meta-model to the two or more enterprises for collaborations between the two or more enterprises according to the standard for collaborations in the negotiated meta-model (§ 2503).

22. Referring to Claim 12, Brodsky teaches communicate the negotiated meta-model to collaboration software of the enterprises, the collaboration software configured to understand and collaborate according to the negotiated meta-model substantially automatically and substantially independent of modification to the collaboration software subsequent to negotiation of the meta-model (§ 16, 2496, 17, 90, 146, 84).

23. Referring to Claim 13, Brodsky teaches wherein the agreement associated with the negotiated meta-model is machine-actionable at the collaboration software of the enterprises and reflects a private, differentiated standard for collaboration customized for particular needs of the enterprises (§ 59, 1115, 1290).

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24. Referring to Claim 14, Brodsky teaches wherein each of the one or more meta-model elements within the set comprise one or more of the following: role types; dimensions each comprising a supply chain element; dimensionalities each comprising a combination of supply chain elements; access of particular role types to particular dimensionalities; collaborative transaction types relative to particular dimensionalities; shared operations visible to the at least two enterprises; temporal structures of collaborative transactions (§ 36, 2493, 2488, 55, 25, 36, 2493, 23, 107).

25. Referring to Claim 15, Brodsky teaches wherein each of the one or more meta-model elements specifying a collaborative transaction type relative to a particular dimensionality comprises one or more of the following: structure of the transaction; data elements associated with the transaction; a state model describing a life cycle of the transaction; access that a role type has to data elements of the transaction relative to a state of the transaction; actions that a role type can execute on the transaction relative to a state of the transaction; whether the transaction is a system of record or whether synchronization must occur with another system of record (§ 248, 2493, 125, 123, 183, 193).

26. Referring to Claim 16, Brodsky teaches wherein the set of the one or more meta-model elements is specified in a template (§ 1344-1363).

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27. Referring to claim 17, Brodsky teaches wherein the meta-model negotiation service comprises a joint business planning network service (JBPNS) (§ 2490, 2503)

28. Referring to Claim 18, Brodsky teaches wherein the meta-model negotiation service is associated with a network service provider through which the enterprises can negotiate the set of one or more meta-model elements (§ 2487).

29. Referring to Claim 19, Brodsky teaches wherein the negotiated meta-model is represented using extensible markup language (XML) (§ 18-21, 79).

30. Referring to Claim 20, Brodsky teaches wherein a collaboration comprises execution of a business process or transaction according to the negotiated meta-model (§ 42, 2503, 792).

31. Referring to Claim 21, Brodsky teaches receive an indication that two or more enterprises wish to negotiate a standard for collaborations between the two or more enterprises (§ 2490, abstract). Brodsky teaches providing the two or more enterprises access to a set of one or more meta-model elements, each of the one or more meta-model elements is incorporated into a negotiated meta-model that describes an agreement between the two or more enterprises as to collaborations between the two or more enterprises, each meta-model element in the set comprising data describing a standard for collaboration between the two or more enterprises (§ 111-131, 146, 168,

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141, 90). Brodsky teaches receive selections of one or more of the meta-model elements for negotiation and incorporation into a negotiated meta-model, the negotiated meta-model describing an agreement between the enterprises as to collaborations between the two or more enterprises (§ 78, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches facilitate negotiation of the selected meta-model elements between the two or more enterprises (§ 2490, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches incorporate negotiated meta-model elements into the negotiated meta-model for collaborations between the two or more enterprises (§ 2503, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches communicate the negotiated meta-model to the two or more enterprises for collaborations between the two or more enterprises according to the standard for collaborations in the negotiated meta-model (§ 2503).

32. Referring to Claim 22, Brodsky teaches communicate the negotiated meta-model to collaboration software of the enterprises, the collaboration software configured to understand and collaborate according to the negotiated meta-model substantially automatically and substantially independent of modification to the collaboration software subsequent to negotiation of the meta-model (§ 16, 2496, 17, 90, 146, 84).

33. Referring to Claim 23, Brodsky teaches wherein the agreement associated with the negotiated meta-model is machine-actionable at the collaboration software of

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the enterprises and reflects a private, differentiated standard for collaboration customized for particular needs of the enterprises (§ 59, 1115, 1290).

34. Referring to Claim 24, Brodsky teaches wherein each of the one or more meta-model elements within the set comprise one or more of the following: role types; dimensions each comprising a supply chain element; dimensionalities each comprising a combination of supply chain elements; access of particular role types to particular dimensionalities; collaborative transaction types relative to particular dimensionalities; shared operations visible to the at least two enterprises; temporal structures of collaborative transactions (§ 36, 2493, 2488, 55, 25, 36, 2493, 23, 107).

35. Referring to Claim 25, Brodsky teaches wherein each of the one or more meta-model elements specifying a collaborative transaction type relative to a particular dimensionality comprises one or more of the following: structure of the transaction; data elements associated with the transaction; a state model describing a life cycle of the transaction; access that a role type has to data elements of the transaction relative to a state of the transaction; actions that a role type can execute on the transaction relative to a state of the transaction; whether the transaction is a system of record or whether synchronization must occur with another system of record (§ 248, 2493, 125, 123, 183, 193).

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36. Referring to Claim 26, Brodsky teaches wherein the set of the one or more meta-model elements is specified in a template (§§ 1344-1363).

37. Referring to claim 27, Brodsky teaches wherein the meta-model negotiation service comprises a joint business planning network service (JBPNs) (§§ 2490, 2503)

38. Referring to Claim 28, Brodsky teaches wherein the meta-model negotiation service is associated with a network service provider through which the enterprises can negotiate the set of one or more meta-model elements (§§ 2487).

39. Referring to Claim 29, Brodsky teaches wherein the negotiated meta-model is represented using extensible markup language (XML) (§§ 18-21, 79).

40. Referring to Claim 30, Brodsky teaches wherein a collaboration comprises execution of a business process or transaction according to the negotiated meta-model (§§ 42, 2503, 792).

41. Referring to Claim 31, Brodsky teaches receive an indication that two or more enterprises wish to negotiate a standard for collaborations between the two or more enterprises (§§ 2490, abstract). Brodsky teaches providing the two or more enterprises access to a set of one or more meta-model elements, each of the one or more meta-

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model elements is incorporated into a negotiated meta-model that describes an agreement between the two or more enterprises as to collaborations between the two or more enterprises, each meta-model element in the set comprising data describing a standard for collaboration between the two or more enterprises (§§ 111-131, 146, 168, 141, 90). Brodsky teaches receive selections of one or more of the meta-model elements for negotiation and incorporation into a negotiated meta-model, the negotiated meta-model describing an agreement between the enterprises as to collaborations between the two or more enterprises (§§ 78, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches facilitate negotiation of the selected meta-model elements between the two or more enterprises (§§ 2490, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches incorporate negotiated meta-model elements into the negotiated meta-model for collaborations between the two or more enterprises (§§ 2503, 36, 2493, 2488, 55, 25, 23, 107). Brodsky teaches communicate the negotiated meta-model to the two or more enterprises for collaborations between the two or more enterprises according to the standard for collaborations in the negotiated meta-model (§§ 2503).

42. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

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of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE H. SWARTZ whose telephone number is (571)272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/J. H. S./

Examiner, Art Unit 3694

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694